

Appl. No. 10/618,472
Docket No. AA-603M
Amdt. dated November 9, 2006
Reply to Office Action mailed on August 23, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1-3 and 5-8 are pending in the present application. No additional claims fee is believed to be due.

Claims 4 and 9 are canceled without prejudice.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §103(a) Over Rice in view of Muhler

Claims 1-3 and 5-8 have been rejected under 35 USC §103(a) as being unpatentable over Rice (USP 5,589,160) in view of Muhler et al (USP 4,108,979). Applicants respectfully traverse.

Rice teaches the use of precipitated silica compositions to improve cleaning without a corresponding increase in dentin or enamel abrasion. (Col. 1, lines 53-55). As noted by the Office Action, Rice suggests that its dentifrice composition can include additional abrasives. But, unlike the present invention, Rice does not teach the use of talc as an abrasive. Rice incorporates three other patents by reference to further describe its optional additional components such as abrasives, but none mention talc as a suitable abrasive.

The Office Action asserts that using talc as an additional abrasive in Rice would have been obvious in view of Muhler's use of a talc abrasive. (Col. 4, lines 6-17). But Muhler's objects are to provide aluminum ions with a compatible abrasive and to have aluminum replace fluoride as the provider of anticariogenic benefits. (Col. 3, lines 3-11). Muhler states that its dentifrice preparations "are predicated on the discovery of a class of abrasive materials that are unusually compatible with aluminum ion sources." (Col. 4, lines 3-6). Given that there have often been problems in dentifrice formulations concerning the compatibility of talc with fluoride, it is not surprising that Muhler, which

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focuses on aluminum to enhance or even replace fluoride, would choose to use talc as an abrasive, while Rice would avoid it.

So while the Office Action contends that it would have been obvious for one of ordinary skill in the art to combine Rice's use of a silica abrasive with Muhler's use of talc, there is simply no teaching or suggestion in Rice to use talc as an additional abrasive. The fact that prior art could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984). "We do not 'pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,' but rather, we look for 'some teaching or suggestion in the references to support their use in the particular claimed combination.'" *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

There is no teaching or suggestion from the references that talc can be used as an additional abrasive in Rice. Therefore, one having ordinary skill in the art would not have been motivated by the teachings of Rice and Muhler to develop the present invention.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §103(a). Early and favorable action in the case is respectfully requested.

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This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of Claims 1-3 and 5-8 is respectfully requested.

Respectfully submitted,

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